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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,595	01/16/2004	Katsukuni Nitta	NITTA1	5392
1444 7590 10/09/2007 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT 1794	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,595

Applicant(s)

NITTA ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/27/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections – 35 USC 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2-7 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, the phrase, "the treatment of the light-shielding layer" lacks antecedent basis as claim 1 does not disclose a treatment.

In claim 6, the phrase, "forgery-preventing treatment" lacks antecedent basis as claim 1 does not disclose a forgery-preventing treatment.

In claim 14, the phrase, "additional thermoplastic resin film is laminated on the surface of the thermoplastic resin film" is indefinite. It is unclear which thermoplastic resin film the additional thermoplastic resin film is laminated on. Clarification is requested.

Objection of Abstract

3. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and

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must be presented on a separate sheet, apart from any other text. The abstract has a line through the page and subsequently has the additional text of best available copy, at the bottom of the page.

Claim Rejections – 35 USC 102(e)

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 6-10, 12-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahashi et al (U.S. 6,562,454).

Takahashi discloses a light shielding layer (E) formed interposed between a thermoplastic resin film layer (A) and a thermoplastic resin film layer (F) (column 9, lines 42-46 and Figure 6) as in claim 1. The light shielding layer is formed by printing (column 9, lines 50-52 and column 14, lines 24-25) as in claim 6. Takahashi discloses the total light transmittance of the article is not greater than 15% (column 2, lines 15-17) as in claim 8. The light shielding layer has a black color by gravure printing, which can comprise aluminum or foil (magnetic material) (column 9, lines 50-52) which meets the limitation of claims 9-10. An additional thermoplastic resin film layer (D) (polyester

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adhesive) is coated on the surface of the thermoplastic resin film (F) (column 10, lines 1-7 and Figure 6) as in claims 14-15. Takahashi discloses the thermoplastic resins used in the invention include polyethylene terephthalate (column 3, lines 1-5) as in claim 16. The thermoplastic resin film layer (A) is coated with calcium carbonate (pigment) (column 14, lines 14-20) which meets the limitation of claim 17. In claim 18, the phrase, "outermost thermoplastic resin film is printable in any mode of electrophotography" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. The outermost layer of the material can be printed using an electrophotographic process, such as an ink jet process (column 10, lines 55-63) as in claim 18. Column 7, line 61-67 discloses the outermost thermoplastic resin is subjected to lamination, as in instant claim 19. Takahashi teaches the material is in the form of a card, security and label (column 1, lines 12-15, 23-25) where a certificate, bill, ticket, check and license are construed as a laminated structure as disclosed in column 1, lines 7-15. Because Takahashi discloses a light shielding layer with a thermoplastic resin film on both sides of the light shielding layer formed by printing, it is inherent for the layer to be shaded, which is invisible by reflected light and visible by transmitting light and for the light part of the material to have a dot ratio of from 5-70 percent, as in claims 2-3 and 7. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not

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cause claim drawn to those things to distinguish over prior art. The Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

In claims 1-2, the phrase, "for forgery prevention" is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In claim 12, the phrase, "formed through vapor deposition of aluminum on the thermoplastic resin film" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

In all of the above mentioned claims, the instant invention includes the preamble language of, "forgery-preventing film". A preamble is generally not accorded any

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patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In the instant case, the preamble merely recites the intended use of a structure, and the body of the claim is able to stand alone; therefore, the preamble language has not been accorded patentable weight.

Claim Rejections – 35 USC § 103(a)

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al (U.S. 6,562,454).

Takahashi does not disclose shading percentage of the light shielding material or weight percentage of adhesive filler as disclosed in claims 4-5 and 11. Takahashi discloses an adhesive applied in an amount of 0.5 to 25 g/m² having a large amount of white filler (column 9, lines 55-59 and column 10, lines 6-7).

Although Takahashi does not specifically disclose the proportion of the shading percentage of the light shielding material or weight percentage of white filler for the adhesive, shading and weight percentage are optimizable features. Applicant fails to

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disclose any criticality with respect to the recited "dark part of the shaded area is at least 90 percent, and that of the light part thereof is at most 10 percent," "light part of the shaded area is from 5 to 12 percent" and "5 to 75 weight percent of white filler."

Therefore, in the absence of any evidence to the contrary, it would have been obvious to one of ordinary skill in the art to optimize the shading of the light shielding material and weight percent of adhesive filler because discovering the optimum or workable range involves only routine skill in the art. The light shielding material shading adhesive filler weight percentage directly affects the aesthetics of the multilayer material. *In re Aller* 105 USPQ 233 and see *In re Boesch*, 617 USPQ 215. In the absence of evidence of criticality for the weight percentage of the adhesive filler material and shading percentage by Applicant, it is obvious to optimize the material. Additionally, there is also no clear teaching away from the shading percentage of the light shielding layer or weight percentage of adhesive filler in the Takahashi reference, as the reference does not exclude any percentages of the light shielding sheet or adhesive.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
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